REMARKS

Claims 51-70 (with independent claim 51 as the main invention and dependent claims 52-70 as the secondary embodiments) are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuse et al. U.S. Patent No. 5,453,348 ("Kuse") considered in view of Price U.S. Patent No. 6,013,422 ("Price") and the known embodiments with respect to Craver et al. U.S. Patent No. 5,652,087 ("Craver") and Yamashita et al. U.S. Patent No. 5,635,341 ("Yamashita"). The applicants respectfully traverse this rejection.

The present invention is a color reversal process that allows to bleach silver halide materials, usually color reversal materials, with a small amount of a highly biodegradable iron complex. Surprisingly, it was found for the claimed compound and the claimed concentration range, that a very low residual silver and yellowing can be achieved and that the bleaching solution is free from precipitations. More specifically, the present invention relates to a color reversal process for processing silver halide materials comprising a bleaching step, wherein said bleaching step is performed using a solution which contains at least one iron complex of propylenediaminetetraacetic acid and the total concentration of the stated iron complex in the solution is at least **0.045 and at most 0.25 mol/l** wherein prior to the bleaching step, the process comprises at least the steps:

first development,

reversal step and

color development (see claim 51).

According to Kuse, the ferric complex salt of formula A can be used in a wide range of 0.002 to 0.4 mol/l; 0.01 to 0.3 mol/l, 0.05 to 0.55 mol/l (see column 4, lines 48-52); and 0.0 to

1.0 mol/l and 0.05 to 0.4mol/l (see claims 2 and 3). There is no teaching from Kuse that the concentration could depend on the formula of the complexant or on the process the complexant is used in. The bleaching solution according to Kuse further has to contain at least a second ferric complex salt (column 4, lines 53-65) and it is preferred that it contains a bleaching accelerator (column 4, starting at line 66).

Therefore, Kuse is silent to elect Fe-PDTA in the concentration as presently claimed for a color reversal process.

The examples of Kuse clearly demonstrate color negative processings that a person of ordinary skill in the art would not have taken into regard for the reversal processing of reversal materials, as Kuse shows silver residues and yellow stain values that are prohibitive for usual color reversal materials. According to Kuse, the residual silver and the yellow stain can only be reduced by unusual fixing agents like iodide or the problematic thiocyanate.

Therefore, the present invention is not rendered obvious by Kuse and a person of ordinary skill in the art would not have combined Kuse and Price, as Price does not disclose how to achieve the objects of the present invention. Moreover, the combination would not lead to the present invention.

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters **without any direction** as to the particular one selection of the reference **without proper motivation**. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious **unless the prior art suggested the desirability of such modification** is suggested by the prior art (In re

Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention; the references themselves must provide some teaching whereby the applicant's combination would have been obvious); In re Dow Chemical Co., 837 F.2d 469,473, USPQ2d 1529, 1531 (Fed. Cir. 1988) (under 35 U.S.C. § 103, both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination, although it may have been obvious to try various combinations of teachings of the prior art references to achieve the applicant's claimed invention, such evidence does not establish prima facie case of obviousness (In re Geiger, 2 USPQ 2d. 1276 (Fed. Cir. 1987)). There would be no reason for one skilled in the art to combine Kuse with Price, Craver and Yamashita.

Therefore, claim 51 and the dependent claims should be patentable and the rejections should be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 07244-00111-USA from which the undersigned is authorized to draw.

Respectfully submitted,

By _____

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